

AMENDMENT UNDER 37 C.F.R. § 1.111
Application Serial No. 10/751,470
Attorney Docket No. Q79189

REMARKS

Upon entry of the present Amendment, claims 1-6 are all the claims pending in the application. Claims 1 and 4 are amended and new claim 7 is added. No new matter is presented.

To summarize the Office Action, claims 1-3 are rejected under 35 U.S.C. § 112, 2nd paragraph, as being indefinite; claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Morita (EP No. 0926675) in view of Del Genio et al (U.S. Patent No. 6,034,850) and admitted prior art; claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Morita in view of Del Genio and admitted prior art, further in view of Martin et al. (U.S. Patent No. 5,868,338, hereinafter “Martin”); claims 4 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Morita in view of Tanaka et al. (U.S. Patent No. 5,180,118, hereinafter “Tanaka”); and claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Morita in view of Tanaka and Martin. The outstanding rejections are addressed as follows.

Claim Rejections - 35 U.S.C. § 112

With respect to the rejection of claims 1-3 under 35 U.S.C. § 112, second paragraph, Applicant submits that this ground of rejection is moot in view of the amendment of claim 1. Accordingly, withdrawal of the 35 U.S.C. § 112, second paragraph, rejection of claims 1-3 is requested.

AMENDMENT UNDER 37 C.F.R. § 1.111
Application Serial No. 10/751,470
Attorney Docket No. Q79189

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1 and 2

As stated above, claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Morita in view of Del Genio and admitted prior art. This ground of rejection is traversed.

Notwithstanding the Examiner's rejection, Applicant submits that the combination of Morita, Del Genio and admitted prior art fails to teach or suggest all the features of claim 1. For instance, claim 1 defines a magnetic tape cartridge comprising, *inter alia*, a cartridge case, formed by fastening upper and lower cases of synthetic resin together, and having a tape leader opening formed in upper and lower side walls of said upper and said lower cases; a single tape reel having magnetic tape wound thereon and rotatably housed within the cartridge case; and a tape leader pin, firmly attached to a leading end of the magnetic tape, and detachably held in an upright state between the upper and lower cases so that the tape leader pin faces the tape leader opening. In addition, claim 1 recites that the tape leader pin has axially opposite flanges and the length of the tape leader pin is 18.7 mm.

In the grounds of rejection, the Examiner contends Morita teaches a magnetic tape cartridge comprising a cartridge formed by fastening upper and lower cases together and having a tape leader opening, a single tape reel magnetic tape, and a tape leader pin detachably held in an upright state between the upper and lower cases. The Examiner further contends that the tape leader pin has axially opposite flanges. However, the Examiner concedes that Morita fails to disclose the features of the upper and lower cases made of synthetic resin, and the recited length

AMENDMENT UNDER 37 C.F.R. § 1.111
Application Serial No. 10/751,470
Attorney Docket No. Q79189

of the tape leader pin of 18.7 mm. Further, The Examiner relies on the teaching of Del Genio merely for forming a cartridge case of synthetic resin.

In addressing the recited length of the tape leader pin, which the Examiner concedes is not taught by either Morita or Del Genio, the Examiner relies on admitted prior art. However, the alleged “admitted prior art Fig. 7A and page 17, line 18 - page 18, line 17” does not teach the claimed length of 18.7 mm. Rather, the portion relied upon by the Examiner discusses a “conventional pin body” in which “the thickness T_1 of the outer flange $5d$ is 1.48 mm and the length L_1 of the pin main body is 19.46 mm.” *See* Specification at page 18, lines 4-6. Further, Applicant disagrees with the Examiner’s characterization of all of page 17, line 18 page, 18, line 17 as “admitted prior art”. In fact, this section presents a “conventional pin body”, as shown in Fig. 7A, in comparison with the “second embodiment”, as shown in Fig. 7B, which is clearly not prior art.

Moreover, the “conventional pin body” does not have a tape leader pin length of 18.7 mm. Rather, the pin length of the conventional tape leader pin is 19.46 mm. To account for this deficiency, the Examiner asserts, “It would have been an obvious matter of design choice to make the leader pin 18.7 mm long since it would have been within the level of skill of an ordinary artisan to determine the optimal pin length using routine experimentation.” *See* Office Action at page 3.

In response, Applicant notes that the Examiner has failed to identify any actual teaching of the admitted prior art or elsewhere in suggest any modification of the conventional tape leader pin length. Instead, the Examiner merely provides a conclusory opinion that an “optimal pin

AMENDMENT UNDER 37 C.F.R. § 1.111
Application Serial No. 10/751,470
Attorney Docket No. Q79189

length" would have been determined. Indeed, the Examiner simply states that "it would have been a matter of obvious engineering choice", without presenting any evidence to support this conclusion. Applicant submits that these conclusory allegations are insufficient to establish *prima facie* obviousness. *In re Zurko*, 258 F.3d 1380, 1386, 59 USPQ2d 1694, 1697 (Fed. Cir. 2001) (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection); *In re Lee*, 277 F.3d 1338, 1343-1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (stating that the "factual question of motivation is material to patentability, and [can] not be resolved on subjective belief and unknown authority.")

Moreover, Applicant notes that the grounds of rejection in no way suggest any range of values for a tape leader pin length for a magnetic tape cartridge, such as the magnetic tape cartridge defined by claim 1. Thus, the Examiner's assertion that determining an "optimal leader pin length" would have been obvious not supported by any actual teaching or suggestion in the applied art. Thus, allegations regarding the "obvious engineering choice" are insufficient to establish *prima facie* obviousness because the Examiner has merely relied on conclusory opinions about what is basic knowledge without any evidence to support the finding.

Further, Applicant submits that the rejection of claim 1 is improper because the Examiner's motivation to modify the admitted prior art is based on impermissible hindsight reasoning. As noted above, the Examiner fails to point to any reference in support of the alleged motivation to modify the conventional tape leader pin. Thus, Applicant submits that the

AMENDMENT UNDER 37 C.F.R. § 1.111
Application Serial No. 10/751,470
Attorney Docket No. Q79189

Examiner has impermissibly relied solely upon the benefits described by Applicant in the specification to provide the motivation to modify the conventional tape leader pin length of 19.46 mm, and the rejection is improper.

Therefore, the combination of Morita, Del Genio and admitted prior art does not teach or suggest all the recited features of claim 1 and the motivation asserted by the Examiner fails to establish *prima facie* obviousness. Accordingly, reconsideration and withdrawal of the rejection of claim 1 is requested. Further, claims 2-3 and 7 are believed to be allowable at least by virtue of depending from claim 1, and allowance of these claims is requested.

Claim 3

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Morita in view of Del Genio and admitted prior art, further in view of Martin. Without commenting substantively on this ground of rejection, Applicant submits that claim 3 is allowable at least by virtue of depending from claim 1.

Claims 4 and 5

Claims 4 and 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Morita in view of Tanaka et al. (U.S. Patent No. 5,180,118, hereinafter “Tanaka”). Applicant respectfully traverses this rejection.

Independent claim 4 defines a magnetic tape cartridge comprising, *inter alia*, a cartridge case, formed by fastening upper and lower cases of synthetic resin together, and having a tape leader opening formed in upper and lower side walls of said upper and the lower cases, a single tape reel having magnetic tape wound thereon and rotatably housed within the cartridge case;

AMENDMENT UNDER 37 C.F.R. § 1.111
Application Serial No. 10/751,470
Attorney Docket No. Q79189

and a tape leader pin, firmly attached to a leading end of the magnetic tape, and detachably held in an upright state between the upper and lower cases so that the tape leader pin faces said tape leader opening. In addition, claim 4 recites metal reinforcement members that are embedded in the upper and lower cases, respectively, near the tape leader opening, in which a first metal reinforcement member is provided above the tape leader pin and a second metal reinforcement member is provided below the tape leader pin.

Applicant submits that the combination of Morita and Tanaka fail to teach or suggest *at least* the feature of the claimed metal reinforcement members. For instance, the Examiner relies on Morita to teach a magnetic tape cartridge comprising a cartridge formed by fastening upper and lower cases together and having a tape leader opening, a single tape reel magnetic tape, and a tape leader pin detachably held in an upright state between the upper and lower cases. However, the Examiner concedes that Morita fails to teach metal reinforcing members.

To account for this deficiency, the Examiner relies on Tanaka. Tanaka teaches a magnetic tape cassette in which side wall portions that come in direct contact with and are held by a tape holder of a recording-reproducing device are made of a pair of side members that are formed independently of the main body. (Tanaka at col. 3, lines 52-57). Tanaka further teaches that the side frame members may be made of a material with a low coefficient of friction, while the main body of the tape cassette is built of a high friction coefficient material such as an elastomer, to ensure smooth release of the tape cassette from the holder. (Tanaka at col. 7, lines 42-47). Tanaka teaches that the side frame members may be of a “high rigidity material to maintain adequate rigidity of the magnetic tape cassette as a whole...” (Tanaka at col. 7, lines

AMENDMENT UNDER 37 C.F.R. § 1.111
Application Serial No. 10/751,470
Attorney Docket No. Q79189

48-52). However, the cassette tape of Tanaka does not include a tape leader portion, as claimed, since the tape is contained within the cassette housing during reproduction and recording. In addition, the side frame members of Tanaka, which are shown as single piece members which are attached to the top, bottom and side surfaces of the cassette housing (see Figures 6-8 of Tanaka), would necessarily cover the tape leader opening if applied to a magnetic tape cartridge of the type taught by Morita.

Thus, the side frame members of Tanaka do not reasonably teach or suggest the claimed metal reinforcement members embedded near a tape leader opening where a first reinforcement member is provided above a tape leader pin and a second metal reinforcement member is provided below the tape leader pin. Therefore, even assuming, for the sake of argument, that the Examiner's asserted motivation to combine the teachings of Morita and Tanaka is proper, the combination would not teach all the claim limitations. Accordingly, reconsideration and withdrawal of the rejection of claim 4 is requested. Further, claims 5-6 are believed to be allowable at least by virtue of depending from claim 4, and allowance of these claims is requested.

Claim 6

As noted above, claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Morita in view of Tanaka and Martin. Without commenting substantively on the grounds of rejection, Applicant submits that claim 6 is allowable at least by virtue of depending from claim 4.

AMENDMENT UNDER 37 C.F.R. § 1.111
Application Serial No. 10/751,470
Attorney Docket No. Q79189

New claim

In order to provide additional claim coverage merited by the scope of the invention, Applicant is adding new claim 7. Claim 7 is believed to be allowable at least by virtue of depending from claim 1.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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